

REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application, and for the personal interview conducted on July 29, 2004. The application has been carefully reviewed in light of the Office action and the interview, and the following remarks are presented for the Examiner's consideration.

Claims 1-8 remain in this application.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (EP 0833 446 A2) in view of Petratos *et al.* (U.S. Patent No. 4,680,676). For the following reasons, the Examiner's rejection is respectfully traversed.

Regarding claim 1, as discussed at the personal interview, neither Sato nor Petratos teaches or suggests a radio terminal device comprising both “a metal housing” and “a resin housing.” Sato describes two *shield cases* (15, 16), stating that “Each of the first and second shield cases 15, 16 is made from resin material” and that “Each of the first and second shield cases 15, 16 may alternatively be made from metallic plate.” However, Sato never discloses or suggests that one of the shield cases must be made of resin and the *other* must be made of metal. In contrast, the claim language requires that both a resin and a metal housing be utilized in the same device. Furthermore, the “*shield case*” of Sato does not teach a *housing* as recited in the claims. Instead, Sato merely teaches that one embodiment utilizes a resin case for each shield case (col. 4, lines 40-43), or alternatively, each shield case utilizes a metallic plate (col. 4, lines 47-50). There is no suggestion at all that the device utilize both in the same embodiment.

Accordingly, since not every limitation of the claim is taught or suggested by the combination of Sato and Petratos, claim 1 and its dependent claims 2-8 are patentable over the prior art of record. At the personal interview, the Examiner agreed to reconsider the rejection

based on the fact that there is no suggestion in any reference to utilize *both* a resin *and* a metal housing in the same device.

In addition, none of the references disclose or suggest that “a part of the printed board is accommodated in the resin housing” as recited in claim 1 *and* “a part of the rear surface side of said printed board is accommodated in the resin housing” as recited in claim 5.

Still further, there is no suggestion or motivation for one skilled in the art at the time the invention was made to combine Petratos with Sato to arrive at the claimed invention. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish *prima facie* obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish *prima facie* obviousness (*Id.*).

The Petratos housing consists of a lower housing and a control head formed of polycarbonate plastic, and a shield is disposed within the housing to provide electromagnetic isolation between logic and radio boards. The Sato housing consists of a cover and a bottom casing, and electromagnetic isolation is provided by first and second shield cases. There is no need or motivation to look at or use the Petratos housing elements, or even electromagnetic isolation characteristics, to modify Sato. Therefore, there is no motivation to combine Petratos with Sato.

The Examiner states in the Office action that “one would find motivation in Petratos simply to create a great or better radio frequency reception.” The Examiner has cited no support

for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination. A conclusory statement of benefit, such as the one provided by the Examiner in the Office action, is not sufficient to show obviousness.

Furthermore, merely listing an advantage of the combination is not sufficient motivation, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

The desirability of modifying the housing configuration of a radio terminal device is found only in the Applicants' own description of the invention, in contrast to the requirement that the teaching or suggestion to make the modification must be found in the prior art, and not based on an applicant's disclosure. Reconsideration and withdrawal of the rejection based upon the combination of references is respectfully requested.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

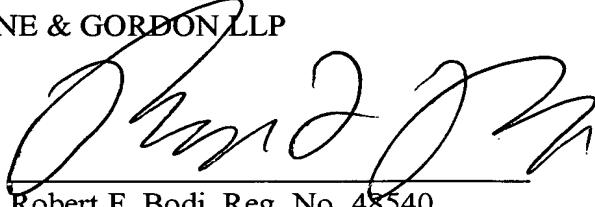
Appl. No. 09/528,126
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Reply to Office action of May 21, 2004

If there are any additional fees resulting from this communication, please charge same to
our Deposit Account No. 16-0820, our Order No. 32439.

Respectfully submitted,

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